

REMARKS

Upon entry of the foregoing amendment, claims 1-5 and 8-19 are pending in the application, with claim 1 being the independent claim. Claims 1-5 are sought to be amended. Claims 8-19 are sought to be added. Claims 6 and 7 are sought to be cancelled by the present amendment without prejudice to or disclaimer of the subject matter therein.

Claims 1-5 have been amended to clarify Applicant's invention, to correct typographical errors, and to put these claims into more typical U.S. claim format. For example, claims 2-5, which depend from claim 1, have been amended to delete "free base" as this phrase is redundant. Claim 3 has been amended to delete the phrase beginning with "if desired, converting" Claim 4 has also been amended to delete the phrase "for use as a pharmaceutical." Claim 1 has been amended to recite the compounds of Examples 1-10, on pages 5-10 of the application as originally filed, and to correct a typographical error by inserting a missing parenthesis in line 5 of the claim.

New claims 8 and 9 are redrafted forms of deleted claims 6 and 7. Thus, support for the addition of these two new claims can be found in claims 6 and 7 as originally filed.

Support for the addition of new claims 10-19 can be found in the specification, for example, at pages 5-10, in Examples 1-6 and 8-10, and in claim 3 as originally filed.

These changes are believed to introduce no new matter, and their entry is respectfully requested. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. (Office Action, at page 2, lines 7-9, at paragraph 4.)

Specifically, the U.S. Patent and Trademark Office ("Office") suggests that claim 1 and 4 are identical. (Office Action, at page 2, line 10, paragraph 4A.)

Applicant respectfully submits that the scope of claims 1 and 4 are not identical, as not all salts are pharmaceutically acceptable salts. However, to expedite prosecution and

without acquiescing to the propriety of the rejection, Applicant has amended claim 4 to recite that the salt recited in claim 1 is a pharmaceutically acceptable salt.

The Office also suggests that claims 2-7 improperly depend upon claim 1 because claim 1 is not claimed in free base form. (Office Action, at page 2, lines 11-12, paragraph 4B.)

Applicant respectfully submits that claim 1 encompasses the free base form of the recited compounds. The term “free base” commonly refers to the neutral form of a base such as an amine, as opposed to its water soluble form (e.g., its salt form). However, to expedite prosecution and without acquiescing to the propriety of the rejection, Applicant has amended claims 2-5 to delete the phrase “free base,” as this term is redundant in these claims. Claim 6 and 7 have been canceled, rendering the rejection moot with respect to these claims.

The Office further suggests that since claim 6 does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. (Office Action, at page 2, lines 13-15, paragraph 5.)

As indicated above, claim 6 has been canceled.

Applicant believes that the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, has been overcome and requests that this rejection be withdrawn.

II. Rejection Under 35 U.S.C. § 101

Claim 6 is rejected under 35 U.S.C. § 101 because recitation of the term “use” allegedly renders the claim non-statutory, and, according to the Office, the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process. (Office Action, at page 2, lines 17-19, at paragraph 6.)

As indicated above, claim 6 has been canceled, rendering moot this basis for rejection.

Applicant believes that the rejection of claim 6 under 35 U.S.C. § 101 has been overcome and requests that this rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 102

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 0 543 780. (Office Action, at page 3, lines 7-8, paragraph 8.) Applicant respectfully traverses this rejection.

Specifically, the Office suggests that the claimed compounds are disclosed in EP 0 543 780 and directs Applicant's attention to the compound of Example 4, at page 8, lines 54-55 of EP 0 543 780.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the compound of Example 4 in EP 0 543 780 fails to anticipate the claimed compounds because, in the Example 4 compound, the pyridyl group at the R₂ position (see Formula I of EP 0 543 780), and the second methylene group in the central propyl group, are each unsubstituted. Applicant notes that the Example 4 compound is the only compound having a pyridyl group in the R₂ position in the examples disclosed in the EP 0 543 780 reference, and this pyridyl group is unsubstituted.

In contrast, all of Applicant's claimed compounds contain a pyridyl group at the R₂ position that is substituted with either a carbonyl group or a methoxy group. In addition, all of the claimed compounds are substituted with a hydroxyl group at the second methylene group in the central propyl chain in the compound.

Because EP 0 543 780 fails to set forth each and every element of the compounds in the pending claims, it cannot anticipate these claims. Accordingly, Applicant believes that the rejection of claims 1, 3-5, and 7 under 35 U.S.C. § 102(b) in view of EP 0 543 780 has been overcome.

Claims 1, 3-5 and 7 are also rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by EP 0 463 560 B1. (Office Action, at page 3, lines 12-13, paragraph 9.) Applicant respectfully traverses this rejection.

The Office suggests that the claimed compounds are disclosed in EP 0 463 560 and directs Applicant's attention to the compound in Example 10 of EP 0 463 560.

Applicant respectfully submits that the compound of Example 10 in EP 0 463 560 fails to anticipate the claimed compounds because the pyridyl group in the Example 10 compound is, again, unsubstituted. This pyridyl group is also a 2-pyridyl group. In contrast, all of Applicant's claimed compounds contain a 3-pyridyl (or 4-pyridyl) group, that is substituted with either a carbonyl group or a methoxy group.

Applicant notes, moreover, that the Example 10 compound is the only example in EP 0 463 560 that contains a pyridyl group, and this pyridyl group is not only unsubstituted, but it is attached at the R2 position (the carbon ring atom adjacent to the nitrogen ring atom).

Because EP 0 463 560 fails to set forth each and every element of the compounds in the pending claims, it cannot anticipate these claims. Accordingly, Applicant believes that the rejection of claims 1, 3-5, and 7 under 35 U.S.C. § 102(b) in view of EP 0 463 560 has been overcome.

Applicant respectfully requests that the rejections of claims 1, 3-5, and 7 under 35 U.S.C. § 102(b) be withdrawn.

CONCLUSION

Based on the foregoing remarks, Applicant respectfully requests that the Examiner reconsider all rejections and that they be withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to

charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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